

## REMARKS

Entry of this Amendment and reconsideration of the above-identified application in view of the following amendments and remarks is respectfully requested

Claims 1-13 are pending and stand rejected.

Claims 1, 8, 12 and 13 are independent claims.

Claims 1, 6, 7, and 8 have been amended. Claims 5, 12 and 13 have been cancelled.

Claims 1-8 and 12-13 stand rejected under 35 USC 103(a) as being unpatentable over Berge (USP no. 6, 369, 954) in view of Borra (The Astrophysical Journal, 516: L115-L118, 1999 May 10) and further in view of Feenstra (WO 03/069380). Claim 9 stands rejected under 35 USC 103(a) as being unpatentable over Berge and Borra and Feenstra further in view of Hugenell (USP no. 5, 430, 577) and Kogelnik (Applied Optics, Vol. 5, No 10, October 1965). Claim 10 stands rejected under 35 USC 103(a) as being unpatentable over Berge and Borra and Feenstra and further in view of Hugenell. Claim 11 stands rejected under 35 USC 103(a) as being unpatentable over Berge and Borra and Feenstra and further in view of Yamada (JP 8-190070).

With regard to the rejection of claims 1- 8 and 12-13 as being unpatentable under 35 USC 103(a) over Berge, Borra and Feenstra, applicant respectfully disagrees with and explicitly traverses the rejection of the claims. However, in the interest of advancing the prosecution of this matter independent claims 1 and 8 have been amended to further recite the elements of the interface adjuster, which alters the configuration of the interface by pulling the edges of the first fluid toward the first electrode of the interface adjuster. No new matter has been added. Support for the amendment may be found at least in cancelled claim 5 and on page 9, lines 1-3.

Berge discloses a variable focus lens comprising a chamber filled with a first liquid, a drop of a second liquid being disposed at rest on a region of a first

surface of an insulating wall of the chamber. The first liquid is conductive and the second liquid is insulating. The lens further comprises means for applying a voltage between the conductor liquid and an electrode placed on the second surface of the wall. Berge further includes centering means for maintaining the centering of the edge of the drop while the voltage is applied and for controlling the shape of the drop.

Berge further discloses, in Figure 6, a chamber 12 including fluid 11 in contact with the inner walls of chamber 12. Electrodes 75-79 are used to apply an electrical charge to the change to change the shape of fluid 11 from position A to position B.

However, Berge is silent with regard to the inner wall including a portion being hydrophilic and a portion being hydrophobic, wherein the contact of the first and second fluid with said inner wall is initially in the hydrophobic portion.

In addition, Berge illustrates in Figures 1, 2 and 6 that the interface between the fluid 11 and the conducting fluid 13 is altered in a manner that the edges of the conducting fluid 13 along the inner walls are pulled away from the electrode 17 in contact with the first fluid. Hence, Berge teaches a feature that is contrary to the subject matter recited in the independent claims.

Borra discloses a method for applying a metal layer to liquids to develop a high-viscosity, high-reflectivity liquids that may be used as a variable mirror surface.

Feenstra is referred to for teaching that the inner walls of a cylindrical surface may include a hydrophilic part and a hydrophobic part and that when no voltage is applied the sides of fluids in the cylinder are positioned axially along the cylindrical surface at the hydrophilic part. Feenstra refers to patent application WO 99/18456 to providing this teaching and a review of the WO 99/18456 reference reveals that this reference also issued as USP 6,369,954 (i.e. Berge).

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations. However, the Court in *KSR v. Teleflex* (citation omitted) has held that the teaching, suggestion and motivation test (TSM) is merely to be used as a helpful hint in determining obviousness and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in the *Graham v. John Deere* (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness) (citation omitted).

In this case, the combination of Berge, Borra and Feenstra fails to render obvious the subject matter recited in the independent claims, as none of the references teaches the element of altering the configuration of the interface via the electrowetting effect such that the edges of the first fluid in contact with the inner wall are pulled toward the first electrode, as is recited in the claims.

For the amendments made to the claims and for the remarks made herein, applicant submits that the reason for the rejection of the independent claims 1 and 8, and the claims dependent therefrom, has been overcome and respectfully requests that the rejection be withdrawn.

With regard to the rejection of claims 9-11 as being unpatentable under 35 USC 103(a) in view of Berge, Borra and Feenstra and the additionally cited references, applicant submits each of these claims depends from claim 1, which has been shown to include subject matter not disclosed by the combination of Berge, Borra and Feenstra, and that the additionally cited references fail to provide any teaching to correct the deficiencies found in the cited references and consequently, in dependent claims 9-11.

Hence, these remaining claims are also allowable by virtue of their dependency upon an allowable base claim.

With regard to the rejection of claims 12 and 13, applicant has requested

that these claims be removed from further consideration at this time.  
Accordingly, the rejection of these claims is believed to no longer be applicable  
and withdrawal of the rejection is respectfully requested.

For the amendments made to the claims and the remarks made herein,  
applicant submits that all the claims are in allowable form and respectfully  
requests that a Notice of Allowance be issued.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

In the event the Examiner deems personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at the telephone given below.

No fees are believed necessary for the timely filing of this paper.

Respectfully submitted,

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